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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,237	02/17/2004	Brian Jones	60001.0289US01/MS305239.1	9655
7590 Christopher J. Leonard Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903		02/21/2007	EXAMINER HILLERY, NATHAN	
			ART UNIT 2176	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/21/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/780,237	JONES ET AL.
	Examiner Nathan Hillary	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 November 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 11/22/06.
2. Claims 1 – 20 are pending in the case. Claims 1, 15, and 18 are independent.

Response to Amendment

3. The declarations under 37 CFR 1.132 filed 11/22/06 is insufficient to overcome the rejection of claims 1 – 20 based upon 35 U.S.C. 102(a) as being clearly anticipated by Microsoft as set forth in the last Office action because: fails to set forth facts.
4. Specifically, MPEP 2132.01 states:

A *prima facie* case is made out under 35 U.S.C. 102(a) if, within 1 year of the filing date, the invention, or an obvious variant thereof, is described in a "printed publication" whose authorship differs in any way from the inventive entity unless it is stated within the publication itself that the publication is describing the applicant's work.

Where the applicant is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference by the filing of affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from, applicant.

The rejection can also be overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant's own work. However, if there is evidence that the co-author has refused to disclaim inventorship and believes himself or herself to be an inventor, applicant's affidavit will not be enough to establish that applicant is the sole inventor and the rejection will stand.

If the reference is disclosing applicant's own work as derived from him or her, applicant may submit either a 37 CFR 1.131 affidavit to antedate the reference or a 37 CFR 1.132 affidavit to show derivation of the reference subject matter from applicant and invention by applicant.

5. The first three block paragraphs above are based on the authorship of the publication. Because the publication's authorship can not be discerned from the publication itself nor does the publication itself state that it is describing applicant's own work, a mere declaration or affidavit stating that the publication is applicant's own work is insufficient to remove the publication as a reference under 35 USC 102(a).

6. At this time as described in the fourth block paragraph above, applicant may submit a 1.131 affidavit to antedate the reference or a 1.132 affidavit to show derivation.
7. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence that the cited reference is not prior art under 35 USC 102(a) fails to outweigh the evidence that the cited reference is prior art under 35 USC 102(a).

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1 – 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result.

a. Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for locating and determining data and/or information. This produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.

b. The claims appear to be in the preliminary stages and fall short of the disclosed practical utility. In other words, the claims fail to fulfill and/or reflect the

specific, substantial, and credible utility sought by the disclosed invention, and thus do not produce a useful result.

10. Further, to expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Double Patenting

11. Applicant is advised that should claims 1 – 5 be found allowable, claims 15 – 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1 – 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

14. Referring to claims 1, 15, and 18, the specification does not disclose that the attribute includes a flag structure as claimed. The specification does disclose that the attributes serve as flags for indicating the presence of different kinds of executable code so that a parsing application searching for executable code may either reject the document or continuing parsing the document (p 13, last paragraph).

15. Referring to claim 18, the specification does not disclose that the subsequent application is notified of the presence of the embedded executable code without the subsequent application first parsing all elements of the XML document prior to the embedded executable code. Any negative limitation or exclusionary proviso must have basis in the original disclosure (MPEP 2173.05(i)).

16. **Regarding claims 2 – 14, 16, 17, 19 and 20**, the claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend.

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 1 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. **Regarding claims 1, 15 and 18**, the metes and bounds of “a flag structure” are unclear. Further, it is unclear what applicant means by “the attribute comprises a flag

structure", since it is not defined nor described in the Specification. Therefore, all subsequent recitations of "the attribute" and "the flag structure" are also rejected.

20. **Regarding claims 2 – 14, 16, 17, 19 and 20,** the claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend.

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

22. Claims 1 – 20 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Microsoft (Overview of WordprocessingML).

23. **Regarding independent claim 1,** Microsoft teaches that if you save a Word document with the .xml extension, Windows will treat the file like any other XML file. Adding the mso-application processing instruction specifies Word as the preferred application for processing the file (p 3, first paragraph), which is equivalent to **applying Extensible Markup Language (XML) markup to a computer-generated document.** It should be noted that the Word document of Microsoft is equivalent to the claimed **computer-generated document.**

Microsoft teaches that you'll be introduced to how WordprocessingML stores VBA code and OCX controls. You'll also see how Word ensures that software can detect whether these components are present in the document (p 27, Macros and

Components, first paragraph), which meet the limitation of **locating an executable code embedded in the document**. It should be noted that the VBA code of Microsoft is equivalent to the claimed **executable code**.

Microsoft teaches that two attributes of the wordDocument element are used to indicate the presence of the VBA code and OCX controls. (p 27, Macros and Components, second paragraph), which meet the limitation of **applying an attribute to a root level element of the XML markup for notifying a subsequent application of the presence of the embedded executable code**. It should be noted that the wordDocument element of Microsoft is equivalent to the claimed **root level element of the XML markup** as illustrated in the Table on page 2.

Microsoft teaches that if the attribute, used to indicate that macros are present in the document, is set to "no", then Word won't load a document that has a docSuppData element (p 27, last paragraph), which meet the limitation of **wherein the attribute comprises a flag structure that indicates one of the following: a rejection of the XML document by the subsequent application; and a continuation of parsing the XML document by the subsequent application**. It should be noted that because the attribute can be set to "no", the attribute has a flag structure at least in light of the Specification as explained in the rejection under 35 USC 112, first paragraph.

24. **Regarding dependent claim 2**, Microsoft teaches that you'll be introduced to how WordprocessingML stores VBA code and OCX controls. You'll also see how Word ensures that software can detect whether these components are present in the

document (p 27, Macros and Components, first paragraph), which meet the limitation of **passing the document to the subsequent application; parsing the XML markup by the subsequent application to locate the attribute applied to the root level element of the XML markup applied to the document.**

25. **Regarding dependent claim 3**, Microsoft teaches that if the attribute is present, indicating that macros are supposed to be present, and Word doesn't find a docSuppData element before it finds the body element, Word will not load the document (p 27, last sentence), which meet the limitation of **if the attribute is located by the subsequent application, rejecting the document as corrupted by the embedded executable code.** It should be noted that the Word of Microsoft is equivalent to the claimed **subsequent application.**

26. **Regarding dependent claim 4**, Microsoft teaches that if the attribute, used to indicate that macros are present in the document, is set to "no", then Word won't load a document that has a docSuppData element (p 27, last paragraph), which meet the limitation of **if the attribute is located, determining whether the embedded executable code associated with the attribute requires rejection of the document, and if not, continuing to parse the XML markup of the document by the subsequent application.** It should be noted that the docSuppData element of Microsoft is equivalent to the claimed **embedded executable code** and that the Word of Microsoft is equivalent to the claimed **subsequent application.**

27. **Regarding dependent claim 5**, Microsoft teaches that if the attribute, used to indicate that macros are present in the document, is missing, then Word won't load a document that has a docSuppData element (p 27, last paragraph), which meet the limitation of **parsing the XML markup by the subsequent application includes locating the executable code embedded in the document; determining by the subsequent application whether an attribute is present for notifying the subsequent application of the presence of the executable code; and if the attribute is not present, then rejecting the executable code**. It should be noted that the docSuppData element of Microsoft is equivalent to the claimed **embedded executable code** and that the Word of Microsoft is equivalent to the claimed **subsequent application**.

28. **Regarding dependent claim 6**, Microsoft teaches that the macrosPresent attribute of the wordDocument element is used to indicate the presence of the VBA code (p 27, last two paragraphs), which meet the limitation of **the attribute is a macros present attribute for indicating the presence of VBA code in the document**.

29. **Regarding dependent claim 7**, Microsoft teaches that if the attribute is set to "yes", then it indicates that macros are supposed to be present (p 27, last paragraph), which meet the limitation of **the macros present attribute has a value of "yes" where an XML markup element is in the document containing the VBA code**.

30. **Regarding dependent claim 8**, Microsoft teaches that the macrosPresent attribute is used to indicate that macros are present in the document. If the attribute is set to "no", then it indicates that macros are not supposed to be present (p 27, last paragraph), which meet the limitation of **the macros present attribute has a value of "no" indicating that no XML element is in the file containing the VBA code.**

31. **Regarding dependent claim 9**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have been used in the document (p 28, second paragraph), which meet the limitation of **the attribute is an embedded object present attribute indicating the presence of one or more OLE objects in the document**. It should be noted that an OCX control is simply an OLE custom control, which is equivalent to an OLE object as explained in Microsoft (p 27, first paragraph).

32. **Regarding dependent claim 10**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have been used in the document. If the attribute is set to "yes", then it indicates that macros are supposed to be present (p 28, second paragraph), which meet the limitation of **the embedded object present attribute has a value of "yes" indicating the presence of at least one XML element in the document containing data associated with an OLE object.**

33. **Regarding dependent claim 11**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have been used in the document. If the attribute is set to "no", then it indicates that macros are not supposed to be present (p 28, second paragraph), which meet the limitation of **the embedded object present attribute has a value of "no" indicating that there are no XML elements in the file containing data associated with an OLE object.**

34. **Regarding dependent claim 12**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have been used in the document (p 28, second paragraph), which meet the limitation of **the attribute is an OCX present attribute indicating the presence of OCX objects in the document.**

35. **Regarding dependent claim 13**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have been used in the document. If the attribute is set to "yes", then it indicates that macros are supposed to be present (p 28, second paragraph), which meet the limitation of **the OCX present object attribute has a value of "yes" indicating the presence of at least one XML element in the document containing data associated with an OCX object.**

36. **Regarding dependent claim 14**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have been used in the document. If the attribute is set to "no", then it indicates that macros are not supposed to be present (p 28, second paragraph), which meet the limitation of **the OCX present object attribute has a value of "no" indicating that there are no XML elements in the file containing data associated with an OCX object.**

37. **Regarding claims 15 – 20**, the claims incorporate substantially similar subject matter as claims 1 – 5, and are rejected along the same rationale.

Response to Arguments

38. Applicant's arguments filed 11/22/06 have been fully considered but they are not persuasive.

39. Applicant argues that claims 1 – 20 are statutory because there is production of a concrete, useful and tangible result (p 7, third paragraph).

The Office disagrees.

First, applicant simply states that a concrete, useful and tangible result is produced without pointing out or stating what that result is. The Office maintains that the claimed invention as whole simply locates and determines data without producing a concrete, useful and tangible result.

40. Applicant argues that Microsoft does not teach that the attribute comprises a flag structure that indicates a rejection of the XML document by the subsequent application or a continuation of parsing the XML document by the subsequent application because Microsoft only discloses attributes (p 8, first paragraph).

The Office disagrees.

Microsoft teaches that if the attribute, used to indicate that macros are present in the document, is set to "no", then Word won't load a document that has a docSuppData element (p 27, last paragraph). It should be noted that because the attribute can be set to "no", the attribute has a flag structure at least in light of the Specification as explained in the rejection under 35 USC 112, first and second paragraphs.

Conclusion

41. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NH



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